Black Rock cases seem to have made that very assumption. Many of those numerous decisions have been examined and each of the examined decisions has considered structure but none has mentioned either the *Machine Co.* or the *Bates* case in connection with the issue of validity.

V.

Respondent now argues that the Court of Appeals below did not apply the "clearly erroneous" rule of Rule 52(a) F.R.C.P. in reviewing the question of obviousness under 35 U.S.C. 103 although the Court of Appeals specifically cited the rule in connection with its review on the point A 4. See Reply Brief p. 15.

Respondent seems to forget that it argued before the Court of Appeals that the Court's scope of review was limited by Rule 52(a) and the resulting error by that Court on the point arose from its accepting respondent's argument. Thus, Respondent is indeed "hoist on its own petard."

This important and fundamental error of law should be corrected by this Court.

VI.

Respondent dealt extensively with the merits of the case in its Reply Brief. Even so, respondent studiously avoided commenting on the crux of the decision below,

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The Court of Appeals also stated (A3): "In Lawler, No. 1,315,025 [Appendix 4], and Read, No. 1,986,530 [Appendix 5], virtually the identical combinations were present, however, the analogues of the Svensson lifting means and lining plates were made entirely of metal rather than rubber." Of course, none of the problems involved in the patent in suit are present until one gets away from metal and tries to achieve the desired result with rubber. Reference to Lawler and Read, therefore, only indicates complete lack of comprehension of the issues in the case.

viz., that the combination of the rubber lined ball mill art of Porteous with the solid rubber tire clamping out of Straus and Overman was obvious within 35 U.S.C. 103 despite the fact that respondent, the B. F. Goodrich Co., on of the world's greatest experts in *both* arts, worked on the problem of rubber lined ball mills for forty years and never was able to see this "obvious" combination until after the Skega invention was publicized in the United States whereupon it was promptly copied by respondent.

In the Petition we stated that the decision below was in conflict with *United States v. Adams*, 383 U.S. 39, which we believe controls the instant case. Respondent, at Brief p. 19, distinguished *Adams* from the instant case on the not entirely convincing ground that in one case the plaintiff won and in the other the defendant won. We respectfully request the Court to review *Adams* in connection with the instant Petition.

VII.

CONCLUSION.

This Court took a long step forward toward bringing about "uniformity and definiteness" in patent decisions when it decided the *Graham* case in 1966. However, that decision seems to have created new uncertainty and indefiniteness in that the lower courts were not instructed, even inferentially, to consider differences in the mode of operation and results between the devices of the prior art and of the patent in suit. That uncertainty and indefiniteness was increased by the repetition in the *Black Rock* case of the instructions in the *Graham* case.

As a result, it is not clear whether the rule of *Machine Co.* and *Bates* is still in force, has been overruled or has been abolished. Counsel cannot advise clients on the question of whether the factors of mode of operation and re-

sults are to be considered in determining patent validity. Inventors and patent owners cannot decide that question for themselves. The courts are not advised by the *Graham* and *Black Rock* decisions as to whether the rule of *Machine Co.* and *Bates* is to be observed or ignored.

This Court can take a further step which would remove that uncertainty and indefiniteness by giving instructions to the lower courts to follow the rule of the *Machine Co.* and *Bates* cases in ascertaining the differences between the prior art and the claims at issue. That step can be taken in this case if the present Petition is granted. If the Petition is denied, the present confusion and indefiniteness will continue.

If the rule of *Machine Co.* and *Bates* which has stabilized part of the patent law for so many years has been overruled or abolished, that rule should be given public burial. If that rule still lives, the courts and the public should be informed of that fact.

Respectfully submitted,

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